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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,471	03/11/2004	Kenneth David Harris JR.	033964-110	7419

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EXAMINER	
THANH, QUANG D	

ART UNIT	PAPER NUMBER
3764	

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/798,471	HARRIS ET AL.	
	Examiner	Art Unit	
	Quang D. Thanh	3764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *18* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17 and 19-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 6-23-04
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-17 and 19-20, drawn to a massager unit, classified in class 601, subclass 72.

   II. Claim 18, drawn to a method of providing massage therapy using a massager unit, classified in class 128, subclass 898.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process for using the product of group II as claimed can be practiced with another materially different product that does not include all the elements as required by the product of group I.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Tim Brackett on 12/12/2005, a provisional election was made without traverse to prosecute the invention of group I, claims 1-17

and 19-20. Affirmation of this election must be made by applicant in replying to this Office action. Claim 18 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

6. Claims 8-9 are objected to because of the following informalities: "the power supply **means**" lacks antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1,3,7,9-16 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Cheng (5,336,159).

9. Re claims 1,3,7,9-16 and 19, Cheng discloses a massager unit 1 (fig. 1-2), comprising: an elongate handle 11 having a first end and a second end; a first massage head disposed at the first end of the handle; a first motor (means for vibrating) 22 operatively coupled to the first massage head; a second massage head disposed at the second end of the handle; and a second motor 22 operatively coupled to the second massage head (fig. 1, col. 1, lines 45-55); at least one first weight 23 coupled to the first motor, wherein the first weight is offset (fig. 1) from an axis of rotation of the first motor, thereby causing vibrations as the first weight rotates, and at least one second weight 23 coupled to the second motor, wherein the second weight is offset from an axis of rotation of the second motor, thereby causing vibrations as the second weight rotates; a power supply 6, wherein the power supply is external to the massager unit; wherein the power supply s is coupled to alternating current (AC) power (col. 2, lines 20-22); and a switch 111 operable to independently control the first motor and the second motor (col. 2, lines 20-25); wherein an active massage area of the first massage end further comprises a substantially oval-shaped dome (best seen in fig. 2); wherein an active massage area of the first massage end further comprises a plurality of hemispheres 4 (fig. 2); wherein an active massage area of the first massage end further comprises a plurality of conical shapes 4 (fig. 2); wherein the handle has a substantially convex contour to fit a hand of a user (fig. 2); wherein the handle is substantially cylindrical (fig. 2); wherein the handle is substantially rectangular (top view in fig. 3).

10. Claims 1-6 and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor (5,611,771). Taylor discloses a massager unit 10 (fig. 1), comprising: an elongate handle 11 (including 15 and 20, 20', fig. 1) having a first end and a second end; a first massage head 13 disposed at the first end of the handle (fig. 1); a first motor 26 (means for vibrating) (fig. 4) operatively coupled to the first massage head; a second massage head 13' disposed at the second end of the handle; and a second motor 26' operatively coupled to the second massage head; a first switch 21 (means for controlling vibrating means) operable to control the first motor; and a second switch 21' operable to control the second motor (fig. 1); at least one first weight 27 coupled to the first motor 26 (fig. 4), wherein the first weight is offset (eccentric weight 27, fig. 4) from an axis of rotation of the first motor, thereby causing vibrations as the first weight rotates, and at least one second weight 27' coupled to the second motor 26', wherein the second weight is offset from an axis of rotation of the second motor, thereby causing vibrations as the second weight rotates; a power supply contained within the elongate handle wherein the power supply is operatively coupled to the first motor and the second motor to provide electrical power to the first motor and the second motor; wherein the power supply is at least one battery (col. 3, line 65 to col. 4, line 5); the handle further comprises a cavity 15 constructed and arranged to retain the at least one battery (col. 3, line 65 to col. 4, line 5).

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claim 17 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim of U.S. Patent No. D510,441. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim of U.S. Patent No. D510,441 teaches all the limitations recited in claim 17 of the invention including depressions located on the upper portions of each massaging head, except it is silent regarding the second end being used as a massaging head. However, it would have been obvious to one of ordinary skill in the art at the time of invention was made to use the U.S. Patent No. D510,441's second end as a massaging head.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng. Cheng discloses the claimed invention except for an external battery for supplying the power to the device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an external battery since the examiner takes Official Notice of the equivalence of a battery and a power cable for their use in the massager art and the selection of any of these known equivalents to supply the power to the massager would be within the level of ordinary skill in the art.

14. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tarjoto (D338,964) in view of Tsai US2005/0203445. Tarjoto discloses a massager comprising: an elongate handle (fig. 1) having a first end and a second end; a first massage head disposed at the first end of the handle and having a lower portion comprising an active massage area (fig. 1); a second massage head disposed at the second end of the handle and having a lower portion comprising an active massage area whereby the second massage head is wider than the first massage head (fig. 2 and 5), except for two depressions each located on the corresponding massage head. However, Tsai teaches a massager comprising two massaging heads, each head has a depression (grip section 101, fig. 1) suitable for the gripping of fingers and hand (paragraph 23). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to modify the massager in the Tarjoto's reference, to include

depressions (grip sections) disposed on the massage heads, as taught and suggested by Tsai, for the purpose of providing gripping means suitable for the gripping of fingers and hand, thus would allow the user to firmly grip the massager during use.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Harris et al. (D466612) teaches a pinpoint massager.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang D. Thanh whose telephone number is (571) 272-4982. The examiner can normally be reached on Monday-Thursday & alternate Friday.
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Huson can be reached on (571) 272-4887. The Central FAX phone number for the organization where this application or proceeding is assigned is (571) 273-8300 for all communications.
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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